

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICTDISTRICT OF NEW YORK

ROKU INC.,)	
)	CASE NO. 1:22-cv-202
Plaintiff,)	
)	Defendant CHUNGHOP
vs.)	STORE's Response to the OSC
)	
Entities on Schedule A,)	
)	
Defendants.)	

DEFENDANT CHUNGHOP STORE'S RESPONSE TO THE OSC

Defendant CHUNGHOP STORE is filing to response in opposition to Plaintiff's Motion for Preliminary Injunction because Plaintiff failed prove tha there is likelihood of success on the merit of the case.

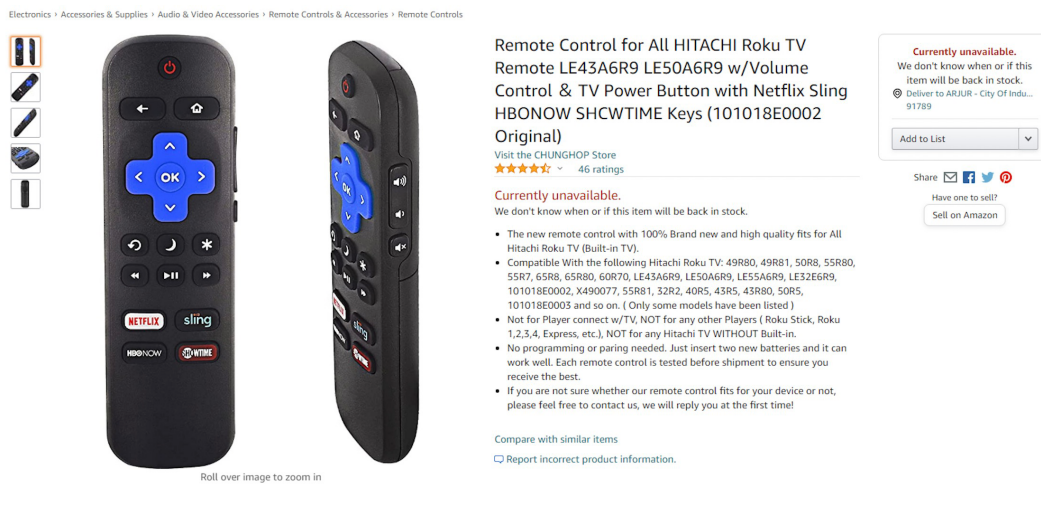
In order for a movant to prevail on its motion for a preliminary injunction, it must demonstrate both "(a) irreparable harm and (b) either a likelihood of success on the merits or sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly in the movant's favor." *United States Shoe Corp. v. Brown Grp., Inc.*, 740 F. Supp. 196, 197 (S.D.N.Y. 1990)

To prove infringement, a trademark owner must demonstrate that the alleged infringer's use of the mark is likely to cause confusion or mistake as to the origin of the two products. When a mark is made of descriptive terms, the alleged infringer may defend his use of the terms by demonstrating that he used them in good faith in their descriptive sense and not as a trademark, thus making "fair use" of descriptive terms, as codified in Section 33(b)(4) of the Lanham Act. *Id.* at 198. Defendant that is not using the

phrase as an identifier or trademark to indicate origin or source is not infringing the mark.
Id. at 199.

Defendant's Use The Word "ROKU" Is Descriptive Fair Use

Defendant is an internet seller that sells replacement remote controls for TVs, including Roku TV. For all Defendant's products, Defendants either used the words remote control for Roku TV or remote control compatible with Roku TV. Without using the word "Roku," consumers have no clue whether the replacement remote will work with Roku TV. Just like phone charger sellers that state charger compatible with Apple or Samsung, there is no way to get around the usage of trademarked words to describe the compatibility of certain after-market products. Moreover, Defendant is not using the word as a trademark or identifier to indicate origin or source of the product. Instead, it is used in a sentence to indicate the compatibility of the product. Defendant clearly indicated that this product is CHUNGHOP, which is in enlarged bond font. There is no likelihood that a consumer will confuse this mark with Plaintiff's mark. See the screenshots below for Defendant's products.



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Product Description



CHUNGHOP replacement remote control
NS-RCRUS-17 compatible with Insignia
Roku Smart TV Remote Insignia Roku
smart HDTV 4K UHD LED HDR TV remote



CHUNGHOP replacement remote control NS-RCRUS-17 compatible with insignia roku smart tv remote insignia roku smart 4K HDTV HDR UHD TV remote fit for 24, 32, 39, 40, 43, 48, 49, 50, 55, 65 inch LED LCD TV and 720p, 1080p Class HDTV tv remote.

Compatible with the following Insignia Roku TV: NS-24ER310NA17, NS-32DR310NA17, NS-48DR510NA17, NS-24ER310NA17, NS-55DR710NA17, NS-50DR710NA17, NS-43DR620NA18, NS-50DR620NA18, NS-55DR620NA18, NS-65DR620NA18, NS-50DR620CA18, NS-55DR620CA18, NS-39DR510NA17, NS24ER310NA17, NS32DR310NA17, NS48DR510NA17, NS43DR710NA17, NS55DR710NA17, NS50DR710NA17, NS43DR620NA18, NS50DR620NA18, NS55DR620NA18, NS50DR620CA18, NS55DR620CA18, NS39DR510NA17, NS-32DR420NA16, NS-32DR420NA16A, NS-32DR420NA16B, NS-40DR420NA16, NS-40DR420NA16B.

Also fit for following models:

NS-RCRUDUS-17 (p/n: 398GR10BEBYN000) NS-RCRUS-19 (p/n: NSRCRUS19)

NS-RCRUDCA-18 (p/n: 398GR10BEBYN0007) NS-RCRUS-18 (p/n: NSRCRUS18)

NS-RCRUDUS-18 (p/n: 398GR10BDBYN0006) NS-RCRUS-20 (p/n: NSRCRUS20)



Fast and Convenient

With Netflix, Google Play, Hulu and Sling Keys, you can choose your favorite channel easily!



Long Distance

The maximum control far of the AN-MR500G remote control distance is about 10m / 33ft.



2*AAA Batteries
Batteries is not included

Installing Batteries

- 1.Remove the battery cover from the remote
- 2.Put the new AAA batteries into the remote.
- 3.You can control your player with your remote

No programming or pairing Needed. Just install two new batteries and ti can work well.
Notice: the batteries are NOT included.

Plaintiff Failed To Prove that Design Only Mark 6076830 Is Protectable
Under Common Law

Registration of a mark on a supplemental register cannot give validity to a mark, the use of which would be invalid at common law. *C&L Int'l Trading, Inc. v. Am. Tibetan Health Inst., Inc.*, 2013 U.S. Dist. LEXIS 164393, at *7-8 (S.D.N.Y. Nov. 18, 2013). Accordingly, plaintiffs may obtain the relief provided by the Lanham Act **only if** their marks are entitled to protection under common law — that is, if their marks are sufficiently distinctive to distinguish their goods from the goods of others. *Id.* at 8 citing *Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 381 (2d Cir. 2005). (emphasis added). "Such distinctiveness may be demonstrated in either of two ways. The mark may be 'inherently distinctive' if its intrinsic nature serves to identify its particular source. Alternatively, even if not inherently distinctive, the mark may be distinctive by virtue of having acquired a 'secondary meaning' in the minds of consumers." *Id.* "A mark or trade name has acquired secondary meaning if a purchaser will associate it with a certain producer, and will be likely to make that same association when an identical mark (or a confusingly similar mark), is used on another producer's product. *Id.* at 8-9 citing *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 993 (2d Cir. 1987).

Here, unlike what Plaintiff claimed in its claim that

"The ROKU Trademarks are distinctive and identify the merchandise as goods from Plaintiff. The registrations for the ROKU Trademarks constitutes prima facie evidence of their validity and of Plaintiff's exclusive right to use those trademarks pursuant to 15 U.S.C. § 1057(b). " Paragraph 18 on [Dkt 1].

Plaintiff's design only mark 6076830 is non distinctive mark, the registration of which is invalid. Even the trademark examiner commented that "the applied-for mark **fails**

to function as a trademark because it consists solely of a color used on the goods.”

(emphasis added). In the office action, trademark examiner explained that

“Color marks are never inherently distinctive and can only be registered on the Supplemental Register or on the Principal Register with sufficient proof of acquired distinctiveness. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63, 34 USPQ2d 1161, 1162-63 (1995); *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 & n.4 (TTAB 2017) (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000)); TMEP §1202.05(a).”

The examiner further noted that

“The burden of proving that a color mark has acquired distinctiveness is substantial. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (holding the color pink used on fibrous glass residential insulation to have acquired distinctiveness based on evidence of twenty-nine years’ use, extensive affidavit and documentary evidence, surveys, and extensive media advertising expenditures); *In re Am. Home Prods. Corp.*, 226 USPQ 327 (TTAB 1985) (holding combination of colors pink, white and yellow used on an analgesic/muscle relaxant tablet to have acquired distinctiveness based on evidence of more than twenty years’ use, extensive advertising, and sales of over two billion tablets from 1960-1980); *cf. In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998). A mere statement of long use is not sufficient; an applicant must provide evidence demonstrating that the color mark has acquired source-indicating significance in the minds of consumers. TMEP §1202.05(a); *see* TMEP §1212.06.”

See **Exhibit 1** for trademark examiner’s office action of refusing the mark on the principal register.

Plaintiff neglected to respond to this portion of the office action and failed to provide any evidence that support sufficient proof of acquired distinctiveness. Instead, Plaintiff elected to register this mark, after being finally refused by the USPTO, on the Supplemental Register, knowing that this mark lacks sufficient distinctiveness among many other similar designs on the market.

Plaintiff also failed to prove or even did not bother to prove that this mark is sufficiently distinctive to afford a common law protection. All Plaintiff stated on the

Complaint was merely 4 paragraphs filled with conclusory boilerplates, **6 sentences in total**. For example, Plaintiff claimed that

“The ROKU Trademarks are and have been the subject of substantial and continuous marketing and promotion by Plaintiff and Plaintiff has and continues to widely market and promote the ROKU Trademarks in the industry and to consumers. Plaintiff’s promotional efforts include — by way of example but not limitation — substantial print media, the ROKU Products’ website and social media sites, and point of sale materials.”

See paragraph 17 on [Dkt 1]

Plaintiff then stated that

“The ROKU Trademarks are distinctive and identify the merchandise as goods from Plaintiff.” See paragraph 18 on [Dkt 1].

Again, without any substantive evidence to support how this color mark becomes distinctive.

Plaintiff even stated that

“The registrations for the ROKU Trademarks constitutes prima facie evidence of their validity and of Plaintiff’s exclusive right to use those trademarks pursuant to 15 U.S.C. § 1057(b).” See paragraph 18 on [Dkt 1].

This is totally wrong because registration on the supplemental register is NOT prima facie evidence of their validity and of Plaintiff’s exclusive right to use those trademarks pursuant to 15 U.S.C. § 1057(b), which is clearly ruled in *C&L Int’l Trading*.

Plaintiff essentially glossed over the serious question raised by the trademark office that this mark is not protectable under the Lanham Act and falsely led the Court to believe that it has already registered the mark on the principal register.

United States of America

United States Patent and Trademark Office



Reg. No. 6,076,830

Registered Jun. 09, 2020

Int. Cl.: 9

Trademark

Supplemental Register

Roku, Inc. (DELAWARE CORPORATION)
150 Winchester Circle
Los Gatos, CALIFORNIA 95032

CLASS 9: Remote controls for televisions; Remote controls for speakers, digital media streaming devices, televisions, monitors, media players, and audio and video receivers and transmitters; Computer hardware for controlling speakers, digital media streaming devices, televisions, monitors, media players, and audio and video receivers and transmitters; Electronic controllers for speakers, digital media streaming devices, televisions, monitors, media players, and audio and video receivers and transmitters; Wireless controllers to monitor and control the functioning of other electronic devices; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems, namely, speakers, digital media streaming devices, televisions, monitors, media players, and audio and video receivers and transmitters

FIRST USE 7-31-2011; IN COMMERCE 7-31-2011

The color(s) purple is/are claimed as a feature of the mark.

The mark consists of the color purple as applied to portions of a remote controller, wherein the color purple is applied to the entirety of the exterior surface of a directional control button located on a remote control for a streaming video player. The outline of the goods is intended to show the position of the colors on the goods and forms no part of the mark serving as positional reference only.

OWNER OF U.S. REG. NO. 4336488

SER. NO. 88-434,630, FILED P.R. 05-17-2019; AM. S.R. 02-11-2020



Andrew Korman

Plaintiff's Design Only Mark 6076830

Even if Plaintiff's color mark is protectable under common law, there is no infringement because Defendant's cross button is **blue** while Plaintiff claimed **purple** as the mark, which is sufficient different.

**Plaintiff Failed to Provide Notice of the Complaint and
the Show Cause Hearing Order**

To this day, Defendant did not receive any single email from Plaintiff about the Complaint, the Show Cause Hearing Order, or any other notice that there is a Show Cause hearing coming up very soon until the undersigned checked the Court docket couple days ago when Defendant first retained the undersigned. Defendant will be unfairly prejudiced if the preliminary injunction is entered due to Plaintiff's inequitable conduct of not serving Defendant any notice of this hearing, knowing that Defendant resides in China.

CONCLUSION

For the reasons above, Defendant respectfully requests that this Court not enter the preliminary injunction.

Respectfully submitted,

Jan 28, 2022

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